

### **Remarks/Arguments**

Applicant thanks the Examiner for careful consideration of the application.

No claims have been allowed by the Examiner.

#### **I. Claim Objections:**

Applicant thanks Examiner for pointing out that Applicant may have intended dependent claim 2 to depend on independent claim 1. Applicant notes that claim 2 properly depends on dependent claim 13 because claim 13 provides the proper antecedent basis for "said depression" found in claim 2.

#### **II. Rejections under 35 U.S.C. §102(b):**

On page 2 of the Office Communication Examiner has rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by German Gebrauchsmusterschrift DE 200 08 512 U1 to Adoma GmbH ("Adoma"). Applicant has enclosed a translation of Adoma along with this response. This rejection is respectfully traversed with regard to claim 1 because all of the elements of the claimed invention are not present in the cited reference

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *MPEP 2131*. The identical invention must be shown in as complete detail as is contained in the . . . claim. *MPEP 2131* citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (*Fed. Cir.* 1990).

Independent claim 1 discloses a gyroscopically stabilized throwable implement comprising "a disk-shaped body having an essentially convex first surface and an essentially *concave second surface*; and a plurality of *flexible fingers disposed in a first circle on said second surface* and protruding for a predetermined distance away from said second surface, said first circle having a center essentially concentric

with an axis of rotation of the implement," as it is disclosed, defined, and claimed, in independent claim 1, by the Applicant in the instant specification. *Emphasis added.* In contrast, Adoma teaches a "disk for throwing [that] is provided with a recessed part that is covered by a removable cover. The recessed part and the cover define a flat cavity, which can be used to mount and load therein a flat object, in particular a compact disk. Page 2, paragraph 3. In addition, Adoma discloses, "[t]he cover is preferably held in place clamped so that on the edge region of the cover or of the recessed part is arranged a continuous or discontinuous reinforcement . . . ." Page 2, paragraph 4. Further, Adoma discloses, "the recessed part is preferably equipped with a centrally arranged clamping device, which is constructed in particular to achieve concentric, clamping mounting support for a compact disk." Page 2, paragraph 5. Thus, Adoma discloses a throwing disk having a recessed part, formed in the top or convex surface of the disk (see figures 1-3 of Adoma) that holds a compact disk and is covered with a removable cover. Adoma does not disclose, teach, or suggest a throwable implement having a plurality of flexible fingers disposed in a first circle on the second surface (i.e. essentially concave surface) and that protrude away from the second surface.

Thus, because Adoma does not disclose, "a disk-shaped body having an essentially convex first surface and an essentially *concave second surface*; and a plurality of flexible fingers disposed in a first circle *on said second surface* and protruding for a predetermined distance away from said second surface, said first circle having a center essentially concentric with an axis of rotation of the implement," as recited in independent claim 1; Adoma does not anticipate or render obvious independent claim 1 nor dependent claims 2-5, and 13, which depend on independent claim 1, since "a disk-shaped body having an essentially convex first surface and an essentially *concave second surface*; and a plurality of flexible fingers disposed in a first circle *on said second surface* and protruding for a predetermined distance away from said second surface, said first circle having a center essentially concentric with an axis of rotation of the implement," are elements of the claimed invention arranged in a manner distinct from that disclosed in Adoma.

Since a proper anticipation rejection requires that there be present in a single prior art reference a disclosure of all of the elements of the claimed invention arranged as in the claims, Applicant believes that Adoma does not anticipate the present invention. *See* MPEP 2131. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 1, based on Adoma under 35 U.S.C. § 102(b).

### **III. REJECTIONS UNDER 35 U.S.C. §103(a)**

Examiner has rejected claims 1, 2, and 13 under 35 U.S.C. § 103(a) as being obvious (claim 1), and unpatentable (claims 1, 2, and 13) over German Gebrauchsmusterschrift DE 200 08 512 U1 to Adoma GmbH ("Adoma"). This rejection is respectfully traversed with regard to claims 1, 2, and 13 since neither Adoma, nor Adoma in combination with Examiner's remarks teach, suggest, or mention the claimed invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, i.e. the prior art must suggest the desirability of the claimed invention. There must be a reasonable expectation of success. Finally to establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. MPEP 2143.03 (*citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). These requirements are not met here.

In regards to independent claim 1, independent claim 1 discloses a gyroscopically stabilized throwable implement comprising "a disk-shaped body having an essentially convex first surface and an essentially *concave second surface*; and a plurality of flexible fingers disposed in a first circle *on said second surface* and protruding for a predetermined distance away from said second surface, said first circle having a center essentially concentric with an axis of rotation of the implement," as it is disclosed, defined, and claimed, in independent claim 1, by the

Applicant in the instant specification. As described above Adoma discloses a throwing disk having a recessed part, formed in the top or convex surface of the disk that holds a compact disk and is covered with a removable cover. Thus, Adoma does not teach the present invention as recited in independent claim 1, and thus, does not meet any of the three basic criteria that must be met to establish a *prima facie* case of obviousness under MPEP §2143. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 1 based on Adoma under 35 U.S.C. § 103(a).

In addition, in regards to independent claim 1 and dependent claims 2 and 13 Examiner states that Adoma may fail to teach a plurality of flexible fingers. Applicant believes that Adoma does fail to teach a plurality of flexible fingers. Examiner further states "it would have been obvious to one having ordinary skill in the art . . . to incorporate a plurality of flexible fingers on the implement of Adoma for the purpose of retaining the compact disk." Applicant believes such a statement is not sufficient to establish a *prima facie* case of obviousness. *See MPEP* 2143.01. The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be reasoned from knowledge generally available to one of ordinary skill in the art. *See MPEP* 2144. However, Examiner must present convincing line of reasoning supporting such a rejection. *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985). Applicant respectfully disagrees with Examiner that the limitations set forth in independent claim 1 are obvious in view of Examiner's remarks. Further, Applicants believe that Adoma neither discloses, teaches, or suggests the limitation "a lip edge forming a peripheral boundary of said depression at said second surface" found in claim 2 nor the limitation "a depression disposed in said second surface, having an essentially flat bottom" found in claim 13. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 1 and dependent claims 2 and 13 based on Adoma in view of Examiner's remarks.

If Examiner does not withdraw the obvious rejection, Examiner is respectfully requested to either cite a particular reference or provide an affidavit, that it would have been obvious at the time the invention was made, to a person having ordinary skill in the art, to modify the invention of Adoma so that it would have the claimed limitations set forth in independent claim 1. Examiner is requested to provide specific factual findings predicated on sound technical and scientific reasoning to support Examiner's conclusion of common knowledge and mere engineering choice. *See MPEP 2144.03.*

Examiner has rejected claims 1-5 and 13 under 35 U.S.C. § 103(a) as being unpatentable over German Gebrauchsmusterschrift DE 200 08 512 U1 to Adoma GmbH ("Adoma") in view of Nusselder (U.S. Patent No. 4,535,888, "Nusselder") or Otsuka et al. (U.S. Patent No. 4,793,479, "Otsuka"). This rejection is respectfully traversed with regard to claims 1-5, and 13 since neither Adoma, nor Adoma in combination with either Nusselder or Otsuka, teach, suggest, or mention the claimed invention.

In regards to independent claim 1, independent claim 1 discloses a gyroscopically stabilized throwable implement comprising "a disk-shaped body having an essentially convex first surface and an essentially concave second surface; and a plurality of flexible fingers disposed in a first circle on said second surface and protruding for a predetermined distance away from said second surface, said first circle having a center essentially concentric with an axis of rotation of the implement," as it is disclosed, defined, and claimed, in independent claim 1, by the Applicant in the instant specification. As described above Adoma discloses a throwing disk having a recessed part, formed in the top or convex surface of the disk that holds a compact disk and is covered with a removable cover. In addition, Nusselder discloses a "storage cassette for disk-shaped information carriers of the type initially described has a box-like center portion forming an intermediate bottom which also has, at its upper and lower sides a respective cover in the form of a box like floor part for the acceptance of a disk-shaped information carrier." Col. 2, lines 3-8. Further, Otsuka discloses a compact "disc tray 11 made of a rigid plastic resin is

in a generally flat form provided with a disc-engagement structure in the center position having a small raised circular area 12 to serve as a disc mount with a circular center opening 15." Col. 2, lines 44-48. Adoma, Nusselder, and Otsuka do not disclose, teach, or suggest a disk-shaped body having an essentially convex first surface and an essentially concave second surface; and a plurality of flexible fingers disposed in a first circle on said second surface and protruding for a predetermined distance away from said second surface, said first circle having a center essentially concentric with an axis of rotation of the implement." The combination of Adoma and Nusselder, and the combination of Adoma and Otsuka are silent on "a plurality of flexible fingers disposed in a first circle on said second surface and protruding for a predetermined distance away from said second surface." Thus, the Examiner's suggested combination (which may or may not be proper) of Adoma and Nusselder or the combination of Adoma and Otsuka does not teach the present invention as recited in independent claim 1, and thus, does not meet any of the three basic criteria that must be met to establish a prima facie case of obviousness under MPEP §2143. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-5 and 13 based on Adoma in view of Nusselder or Wyatt under 35 U.S.C. § 103(a).

In regards to dependent claims 2-5 and 13 if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP 2143.03. Dependent claims 2-5 and 13 are dependent upon independent claim 1, and are therefore believed to be allowable as dependent upon a believed allowable claim. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of dependent claims 2-5 under 35 U.S.C. § 103(a).

Therefore, in view of the foregoing Amendment and Remarks, Applicant believes the present application to be in a condition suitable for allowance. Examiner is respectfully urged to withdraw the rejections, reconsider the present Application in light of the foregoing Amendment, and pass the amended Application to allowance.

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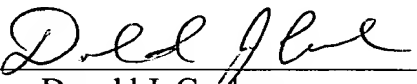
PATENT APPLICATION  
Attorney Docket No: 10014078-1

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's representative at (541) 715-1694 to discuss the steps necessary for placing the application in condition for allowance.

Favorable action by the Examiner is solicited.

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